

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 09/602,412
Attorney Docket No.: A8492

AMENDMENTS TO THE DRAWINGS

Applicant amends Figure 2 to show the claimed features, “determining whether to respond to a request for a web page by retrieving the web page from a cache or by constructing the web page,” and, “if it is determined that the request is to be responded to by constructing the web page.” Applicant respectfully submits that the drawings, as amended, show every feature of the invention specified in the claims. No new matter is being added.

Attachment: One Replacement Sheet

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REMARKS

Claims 1, 3-13, 15-25, and 27-40 are all the claims pending in the application. By this Amendment, Applicant amends claims 1, 13, and 25 and adds claims 41-47.

I. Summary of the Office Action

The drawings are objected to under 37 C.F.R. § 1.83(a). Claims 1, 13, and 25 are rejected under 35 U.S.C. § 112, first paragraph. Claims 1, 3-13, 15-25, and 27-40 are rejected under 35 U.S.C. § 101. Claims 1, 3-13, 15-25, and 27-40 are rejected under 35 U.S.C. § 103(a).

II. Claims Rejected Under 35 U.S.C. § 112

Claims 1, 13, and 25 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner alleges that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Applicant respectfully traverses these grounds for rejection in view of the following comments.

Each claim limitation present in claims 1, 13, and 25 is expressly, implicitly, or inherently supported in the originally filed disclosure. See MPEP § 2163(II)(A)(3)(b), which states:

To comply with the written description requirement of 35 U.S.C. 112, para. 1, or to be entitled to an earlier priority date or filing date under 35 U.S.C. 119, 120, or 365(c), each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. When an explicit limitation in a

claim "is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation." *Hyatt v. Boone*, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998).

Thus, each explicit claim limitation must be supported in the originally filed disclosure, but the support in the disclosure need not be express. It is sufficient that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires a limitation.

With respect to claims 1, 13, and 25, the Examiner alleges that the specification does not properly convey the claimed features, "determining whether to respond to a request for a web page by retrieving the web page from a cache or by constructing the web page," and, "if it is determined that the request is to be responded to by constructing the web page." Applicant respectfully submits that these claim limitations are expressly, implicitly, or inherently supported by the specification.

The specification describes an exemplary embodiment of the invention comprising a web client computer executing a web browser coupled to a server computer executing web server software (page 4, lines 18-19). The specification further describes the software executing on the web server as possibly including a cache management system (page 5, lines 2-3). The specification states that the caching of dynamic web pages enhances the web server's ability to quickly serve web pages containing dynamic content (page 5, lines 17-18). The specification states that the caching of web pages eliminates the costs associated with reconstructing a

dynamic web page that is requested by multiple users (page 5, lines 19-20). The specification further states that if a cached web page is used to respond to a user's request, the processing logic associated with the generation of the cached page is not executed and no changes are made to the data sources (page 6, lines 1-3).

The specification specifically states that a cached page is reused for a request when the URL, the form data, and the query string of the request match the URL, form data, and query string of the request that caused the web page to be cached (page 8, lines 3-5). Thus, in an exemplary embodiment, *it is determined that a request for a web page should be responded to by retrieving the web page from a cache when the URL, form data, and query string of the request match that of the request that caused the web page to be cached.*

Even assuming *arguendo* that the specification does not expressly disclose "if it is determined that the request is to be responded to by constructing the web page," it is implicit in light of the specification that when a request is not to be responded to by retrieving the web page from a cache, the request for the web page would be responded to by constructing the web page. The exemplary embodiment expressly discloses a server computer executing web server software, and a person having ordinary skill in the art in light of the specification would understand that web server software typically responds to a request for a web page by constructing the web page. If a request is not responded to by retrieving the web page from the cache, absent disclosure otherwise, a person having ordinary skill in the art would necessarily understand in light of the specification that the request is responded to by constructing a web page, as is typical for web server software.

Applicants thus respectfully assert that “determining whether to respond to a request for a web page by retrieving the web page from a cache or by constructing the web page,” and, “if it is determined that the request is to be responded to by constructing the web page” are adequately described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully submit that withdrawal of the rejections of claims 1, 13, and 25 under 35 U.S.C. § 112, first paragraph is proper.

III. Claims Rejected Under 35 U.S.C. § 101

Claims 1, 3-13, 15-25 and 27-40 are rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter.

Applicant amends independent claims 1, 13, and 25 to expedite prosecution. As amended, claims 1, 13, and 25 fall within 35 U.S.C. § 101 statutory subject matter. In all conditions, including when it is determined that the request is to be responded to by not constructing the web page, the final result is a useful, tangible result. Applicant respectfully submits that withdrawal of the 35 U.S.C. § 101 rejection of independent claims 1, 13, and 25 is proper.

Claims 3-12, 15-24, and 27-40 depend on independent claims 1, 13, and 25. Applicant respectfully submits that claims 3-12, 15-24, and 27-40 are patentable, at least by virtue of their dependency on the independent claims.

IV. Claims Rejected Under 35 U.S.C. § 103

Claims 1, 3-13, 15-25, and 27-40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,298,373 to Burns et al. (hereinafter “Burns”), in view of

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U.S. Patent No. 7,100,106 to Ramaley et al. (hereinafter "Ramaley"). The Examiner rebutted Applicant's assertion that Burns is not analogous prior art because Burns is not reasonably pertinent to the problem of reducing the expense required to respond to a request for a web page. The Examiner alleges that Burns teaches methods for eliminating latency problems between content providers and local service providers by downloading content at off-peak hours. The Examiner asserts that Burns is thus reasonably pertinent to the problem of reducing the expense required to respond to a request for a web page.

Applicant respectfully submits that Burns deals with a solution implemented at the local service provider level to ensure fast delivery of web pages to subscribers (Burns, col. 1, line 50 – col. 2, line 3; col. 2, line 58 – col. 3, line 32; col. 3, lines 41-57). Burns is not directed to addressing the problem of reducing the expense (e.g., in computing resources or time) incurred by a content provider in responding to users' requests for web pages (page 2, lines 9-12). The problems solved by Burns' disclosure and Applicant's disclosure are markedly different. Burns' deals with the quality of service provided to subscribers by minimizing latency. Applicant's exemplary embodiments of the present invention are directed to reducing the amount of computer resources required by a content provider, among other goals.

A person having ordinary skill in the art would not reasonably have expected to solve the problem of reducing the expense required to respond to a request for a web page by considering a reference dealing with addressing the problem of slow data transfer between content providers' servers and an ISP's servers.

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The differences in function between the disclosure of Burns and Applicant's disclosure are significant and prevent Burns from being classified as analogous prior art.

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992).

Because the disclosure of Burns is neither in the field of Applicant's endeavor nor reasonably pertinent to the particular problem with which Applicant is concerned, Applicant respectfully submits that Burns cannot be relied on as a reference under 35 U.S.C. § 103.

Though Applicant submits that relying on Burns under 35 U.S.C. § 103 is improper because Burns does not constitute analogous prior art, even if Burns and Ramaley are combined, not all claimed limitations are taught or suggested by the combination. For example, among other limitations that are not taught or suggested by the combination, Burns in view of Ramaley does not teach or suggest "determining whether to respond to a request for a web page by retrieving the web page from a cache or by constructing the web page" as disclosed in claim 1, or the corresponding limitations disclosed in claims 13 and 25. Instead, Burns discloses a policy manager 128 that defines and administers rules that determine which documents or resources are cached in the cache memory 124 (Burns, col. 10, lines 50-52). Burns also discloses a request handler 111 that receives a request and looks to the cache memory 124 to determine if a local copy of the requested content is available. But if there is no cached copy, the local service provider 110 uses the URL to locate the target resource from a content provider and request

delivery of the target resource over the Internet (Burns, col. 8, lines 24-40). There is no disclosure regarding responding to a request for a web page by constructing the web page.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). Applicant respectfully submits that, because not all claim limitations of independent claims 1, 13, and 25 are taught or suggested by Burns in view of Ramaley, the claims are patentable. Applicant also submits that dependent claims 3-12, 15-24, and 27-40 are patentable at least by virtue of their dependency on independent claims 1, 13, and 25.

V. New Claims

Applicant adds claims 41-47 in order to provide more varied protection. Claims 41-47 are supported throughout the specification. Claims 41, 43, and 45 are supported, for example, by page 6, lines 16-26 of the specification. Claims 42, 44, and 46 are supported, for example, by page 8, lines 3-5 and page 10, lines 10-12 of the specification. Claim 47 is supported, for example, by page 5, line 17 to page 6, line 3 and page 8, lines 6-7 of the specification.

VI. Drawings Objection

The drawings are objected to under 37 C.F.R. § 1.83(a). Specifically, the drawings must show every feature of the invention specified in the claims. Therefore, the claimed features “determining whether to respond to a request for a web page by retrieving the web page from a cache or by constructing the web page” and “if it is determined that the request is to be responded to by constructing the web page” must be shown or the feature(s) canceled from the claims.

Applicant has amended the drawings and specifically Fig. 2 to show every feature of the invention specified in the claims. Applicant respectfully submits that the drawings, as revised, show the claimed features “determining whether to respond to a request for a web page by retrieving the web page from a cache or by constructing the web page” and “if it is determined that the request is to be responded to by constructing the web page.”

Applicant respectfully submits that the drawings, as amended, are fully supported by the original disclosure in the specification, as argued in § II, above. No new matter is being added.

VII. Statement of Substance of the Interview

Applicant thanks the Examiner for courteous telephonic interviews on April 24, 2007, and April 25, 2007. The Statement of Substance of the Interview is as follows:

During the Interview, claims 1, 13, and 25 were discussed. No agreement was reached. With respect to the newly added claims, the Examiner agreed that the newly added claims 45 and 46 will overcome the rejections of record, subject to further search. The other newly added claims may overcome the rejections of record, subject to further search and consideration.

VIII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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